

REMARKS

I. INTRODUCTION

Claims 1-3 and 5-6 are currently pending in the present application. In the Office Action mailed on July 13, 2005, claims 1-3 and 5-6 have been rejected under 35 U.S.C. § 103(a). In view of the following remarks, Applicants respectfully submit that the pending claims are now in condition for allowance.

II. REJECTIONS UNDER 35 U.S.C. §103 (a)

Claims 1-3 and 5-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over: (1) U.S. Patent No. 6,254,956 ("Kjellqvist *et al.*") in view of U.S. Patent No. 5,571,588 ("Lussi *et al.*"); and (2) International Publication No. WO 98/10160 ("WO 98/10160") in view of Lussi *et al.* Applicants respectfully submit that these rejections should be withdrawn for at least the following reasons.

Regarding the rejections based on Kjellqvist *et al.* in view of Lussi *et al.*, Applicants have the following comments. Applicants respectfully submit that Kjellqvist *et al.* does not qualify as prior art with respect to the present application. The Advisory Action mailed on December 29, 2004 admits that Applicants' foreign priority date of July 14, 1998 predates the 102(e) date of Kjellqvist *et al.* but requires a certified translation of the German priority document so as to perfect the priority date. Because the Examiner has stated that the certified translation submitted with the Amendment mailed on March 24, 2005 "could not be found," Applicants herein enclose another certified translation of the German priority document. Therefore, withdrawal of this rejection is respectfully requested.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F. 2d 931, 934 (Fed. Cir. 1990), *cert. denied* 111 S.Ct. 296 (1990); *In re Bond*, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. *See* M.P.E.P. §2143. Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

WO 98/10160 is directed to a floor, wall or ceiling covering. The covering disclosed by WO 98/10160 “comprises one or more substantially random interpolymers prepared by polymerizing one or more α -olefin monomers with one or more vinylidene aromatic monomers and/or one or more hindered aliphatic or cycloaliphatic vinylidene monomers, and optionally with other polymerizable ethylenically unsaturated monomer(s).” WO 98/10160, abstract. According to WO 98/10160, “[t]he floor, wall or ceiling covering ... may be monolayer or multilayer[, and] [i]n monolayer floor, wall or ceiling coverings such additional, optional polymer(s) is/are blended with the described substantially random interpolymers.” WO 98/10160, page 13, lines 31-35. As stated in WO 98/10160, “[i]n a preferred aspect ... the blend comprises from about 50 to about 99 percent, preferably from about 60 to about 95 percent, more preferably from about 70 to about 90 percent, of the

above-described substantially random interpolymer(s) and from about 1 to about 50, preferably from about 5 to about 40 percent, most preferably from about 10 to about 30 percent of one or more of the above-described homopolymers or interpolymers of aliphatic α -olefins having from 2 to about 20 carbon atoms or α -olefins having from 2 to about 20 carbon atoms and containing polar groups, based on the total weight of the blend. Floor, wall or ceiling coverings containing such blends generally exhibit a good indentation resistance at high load and an excellent scratch resistance.” WO 98/10160, page 23, lines 21-35.

Lussi *et al.* is directed to durable inlaid floor coverings having a uniform, unpatterned decorative appearance which “are made by coating a substrate with, optionally, a smooth layer of tinted latex.” Lussi *et al.*, col. 2, lines 66-67. According to Lussi *et al.*, the optional layer of tinted latex is coated with an adhesive layer, and then a “substantially uniform layer of spheroidal particles having an aspect ratio no greater than about 2:1 is then deposited over the vinyl plastisol adhesive layer to prepare an intermediate product,” which after the application of heat, and preferably pressure, forms the inlaid floor covering (optionally including one or more wearlayers). Lussi *et al.*, col. 3, lines 3-6; *see also* Lussi *et al.*, col. 3, lines 6-17.

In contrast to the teachings of WO 98/10160 in view of Lussi *et al.*, the floor covering of the present invention, as currently recited in independent claim 1, “contains 3 to 20 percent by weight, with respect to the floor covering’s total weight, of a copolymer of ethylene including at least one comonomer selected from the group consisting of

- vinyl esters of saturated carboxylic acids having up to 4 C-atoms in the acid group,
- unsaturated mono- or dicarboxylic acids,
- esters of unsaturated mono- or dicarboxylic acids having up to 8 C-atoms in the alcohol portion, and
- α -olefins having 4 to 10 C-atoms,

the ethylene content of the copolymer being 40 to 95 per cent by weight, the co-monomer content 5 to 60 per cent by weight.” That is, neither WO 98/10160 nor Lussi *et al.* disclose or suggest a floor covering containing a copolymer with an “ethylene content of the copolymer being 40 to 95 per cent by weight, the co-monomer content [being] 5 to 60 per cent by weight.” Thus, WO 98/10160 in view of Lussi *et al.* do not disclose nor suggest each and every element of the presently claimed invention, and Applicants respectfully submit that pending claims 1-3 and 5-6 are thus not rendered obvious by the cited publications.

Moreover, it is respectfully submitted that the cases of *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action’s generalized assertions that it would have been obvious to combine and modify these publications do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the publications relied upon. In particular, the court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598-1600 (citations omitted; italics in original; emphasis added).

Likewise, the court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original; emphasis added).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to combine or modify references to provide the claimed subject matter in order to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for combining or modifying references to provide the claimed subject matter, which the Office has not heretofore done in the present case.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having *no* knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. **With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.** In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (italics in original; emphasis added).

Again, it is believed that there have been no such findings in the present case.

Accordingly, there is no evidence that the publications relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 1 herein. It is therefore respectfully submitted that independent claim 1 is allowable for at least the preceding reasons.

In addition, the Office Action mailed on July 13, 2005 even admits that WO 98/10160 does not disclose the specific percentages by weight of the copolymer and comonomer as currently recited in independent claim 1 (*i.e.*, that the floor covering contains 3 to 20 percent by weight (with respect to the floor covering's total weight) of a copolymer, with the ethylene content of the copolymer being 40 to 95 percent by weight, and the comonomer (as recited in the claim) content being 5 to 60 percent by weight). However, the Office Action alleges that these amounts are result effective variables as affecting the scratch resistance, and concludes that it would have been "obvious to one of ordinary skill in the art to produce the weight percentages as claimed, since it has been held [citing to *In re Boesch*,

617 F.2d 272] that discovering an optimum value of a result effective variable involves only routine skill in the art.” (Office Action mailed on 7/13/05, at page 4).

First of all, Applicants respectfully assert that the claimed amounts (in percentages by weight) as currently recited in independent claim 1 are not result effective variables as alleged in the Office Action. As recited in claim 1, the ethylene content of the copolymer being 40 to 95 percent by weight, and the comonomer content of the copolymer being 5 to 60 percent by weight are in reference to the total weight of the copolymer. In contrast to these weight percentages, the weight percentages of WO 98/10160 purportedly affecting scratch resistance as cited in the Office Action, are in reference to a “blend compris[ing] from about 50 to about 99 percent, preferably from about 60 to about 95 percent, more preferably from about 70 to about 90 percent, of the ... substantially random interpolymer(s) and from about 1 to about 50, preferably from about 5 to about 40 percent, most preferably from about 10 to about 30 percent of one or more of the ... homopolymers or interpolymers of aliphatic α -olefins having from 2 to about 20 carbon atoms or α -olefins having from 2 to about 20 carbon atoms and containing polar groups, based on the total weight of the blend.” WO 98/10160, page 23, lines 21-32. That is, whereas the weight percentages as recited in claim 1 of the present application are in reference to components of a single copolymer, the cited weight percentages of WO 98/10160 are in reference to a blend of different interpolymers, and as such are a different variable altogether from the amounts recited (in weight percentages) in claim 1 of the present application.

Furthermore, Applicants submit that the Office Action’s reliance upon *In re Boesch* is misplaced. In *In re Boesch*, each of the ranges of the constituents in appellants’ claimed alloys overlapped the ranges disclosed by the cited references. *In re Boesch*, 617

F.2d at 272. This is in stark contrast to the present application wherein the Office Action states that WO 98/10160 does not disclose all of the limitations of claim 1, specifically the weight percentages of the polymer and comonomer. The Office Action also does not cite other patents or publications to cure the deficiencies of WO 98/10160.

Thus, for at least the preceding reasons, it is respectfully submitted that pending claim 1, and dependent claim 2-3 and 5-6 therefrom, are not rendered obvious by WO 98/10160 in view of Lussi *et al.* Applicants therefore respectfully submit that the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

III. CONCLUSION

Applicants respectfully submit that the pending claims are in condition for allowance and requests that such action be taken. If for any reason the Examiner believes that prosecution of this application would be advanced by contact with the Applicants' attorney, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,

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